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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,266	04/03/2001	Kim F. Storm	08204/8201348-000	7388
38878	7590	12/06/2006	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 5257 NEW YORK, NY 10150-5257				PATEL, HARESH N
ART UNIT		PAPER NUMBER		
				2154

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/826,266	STORM, KIM F.	
	Examiner	Art Unit	
	Haresh Patel	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 19-29 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 April 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Based on the petition for review by the office of petitions, paper dated 3/3/2006, the abandonment, dated 6/16/2005, is withdrawn and the prosecution is hereby reopened.
2. Claims 1-29 are subject to examination. Claims 1-11 and 19-29 are withdrawn.

Election/Restrictions

3. Applicant has elected claims of Group III (claims 12-18) with traverse.

Applicant argues, "Claims 1-5 and 19-21, drawn to "broadcasting a message including frames to several devices with setting hardware / IP addresses to all addresses on a physical subnet by identifying an unused address and iteratively querying addresses", classified in class 709, subclass 223"; Claims 6-11 and 24-29, drawn to "receiving messages frames and directing them to a specific port of the device, enabling receipt of the frame directed to the specific port on a local port of the device, and disabling receipt on the local port at a specific instance", classified in class 709, subclass 238"; Claims 12-18, drawn to "a system having a network element including a direct access module that is disabled at a particular time after power up, use of an external port, use of an internal port where the direct access module is only enabled, and use of an un-configured management node", classified in class 719, subclass 220; The Commissioner may require restriction if two or more independent and distinct inventions are claimed in a single application (37 CFR 1.142(a)). In the present case, although the claimed subject matter may be classified in different classes, the inventions are not

independent. In particular, the claims of Group I are directed to a method that is substantially performed by the management node of the claimed system of Group III. Also, the claims of Group II are directed to a somewhat similar method that is substantially performed by a network element of the claimed system for Group III. Clearly, all of the claims of the pending patent application are directed to one invention, not three".

The examiner respectfully disagrees in response to the applicant's arguments. It is the claims that define the invention (i.e., each group of the claims claiming respective invention), please refer to *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), and *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970); which very clearly clarifies that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993); and, the First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). As the applicant acknowledged that the claimed subject matter of (the different groups of the claims) are classified in different classes that require different searches and considerations, it is indeed a serious burden on the examiner to simultaneously search and examine the claims of Groups I and II (considering the details of the claimed subject matter of claims of Group I and II, compared to the applicant selected Group III)". Therefore, the examiner maintains that the restriction as indicated is proper, the examiner examines the applicant elected group III (i.e., claims 12-18), and claims 1-11 and 19-29 are withdrawn. (Also, please refer to the office action dated 9/13/2004 for further restriction/election

requirement details). The applicant is requested to cancel the claims 1-11 and 19-29 in response to this office action (with proper claim identifiers).

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

The limitations “direct access module” of claims 12-18 are not recited in the specification.

Drawings

4. New corrected drawings are required in this application because Figures 1-3 do not show “direct access module”. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled --Replacement Sheet-- in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

5. The figure 1 states "Prior Art" without any prior art submitted on the IDS form PTO-1449. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the prior art information using the PTO-1449 form.

Claim Objections

6. Claim 12 is objected to because of the following informalities:

Claim 12 mentions, "residing on", which should be --residing at--

Claim 16 mentions, "predetermined time", which should be --predetermined
amount of time--

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- The following is a quotation of the first paragraph of 35 U.S.C. 112:
- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
7. Claims 12-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification of this application under examination in such a way as to reasonably convey to one skilled in the relevant art to use and/or make the invention.
 8. The specification of this application under examination does not contain subject matter to implement limitations, "direct access module", as cited in claim 12. Also, the

specification does not define what is considered as “direct access module” versus “not direct access module”.

Claims 12-18 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Software component of the management node to force the network element and something that is broadcast by the management node to force the network element, are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim 12 contain, “management node to force the network element”, and “the management node by broadcasting to the direct access module”, but fails to provide what is it that is broadcasted to force the network element. It is not apparent that without broadcasting anything how it is possible to force the network element. Also, it is not apparent that how it is possible to have a management node (hardware) to force the network element (another hardware), without having software elements involved to carryout the forcing and the forcing to be implemented on both entities.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 12-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “direct access” in claim 12 is a relative term, which renders the claim indefinite. It is not apparent how the “direct access” is different than “not direct access”.

Also it is not apparent how the “direct access module” can be accessed without any software/hardware/interface entity. In fact, the claim 13, clearly states usage of Ethernet connection that is used for coupling, which is contrary to the “direct access”.

Claim 16 recite the limitations, “a predetermined time after power up”. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). It is not apparent how the direct access module can power up by itself. Also, considering the predetermined time being infinite, it is not apparent how the direct access module can do anything that is claimed in claim 12.

Regarding claim 18, the phrase "can use" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 12, 13 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al., Netmotion Wireless (Hereinafter Hanson-Netmotion).

12. Referring to claim 12, Hanson-Netmotion discloses a system (e.g., col., 2, lines 45 – 53) comprising: a network element including a direct access module (e.g., col., 2, lines 54 – 67); and

a management node (e.g., col., 3, lines 16 – 29) residing on a same physical subnet as the network element (e.g., col., 34, lines 21 – 36), the management node to force the network element to have an address within an access range of the management node (e.g., col., 3, lines 1 – 39) by broadcasting to the direct access module without reconfiguring the management node (e.g., col., 34, lines 38 – 49).

13. Referring to claim 13, Hanson-Netmotion also discloses the management node and the network element are coupled together by an Ethernet connection (e.g., col., 4, lines 20 – 25).

14. Referring to claim 18, Hanson-Netmotion also discloses the management node can use higher level protocols to manage the network element immediately after forcing the address (e.g., col., 4, lines 40 - 65).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 14, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson-Netmotion in view of Ullmann et al., IBM, 2002/0172222 (Hereinafter Ullmann-IBM).

17. Referring to claim 14, Hanson-Netmotion does not specifically mention about a packet filter to snoop packets arriving at a hardware layer of a protocol stack.

Ullmann-IBM discloses the well-known concept of having a packet filter to snoop packets arriving at a hardware layer of a protocol stack (e.g., paragraphs 131 and 152).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hanson-Netmotion with the teachings of Ullmann-IBM in order to facilitate having a packet filter to snoop packets arriving at a hardware layer of a protocol stack because the filter would support defining parameters for the types and sizes of the packets to be snooped such as all packets associated with particular endpoints or only certain types of packets.

18. Referring to claim 17, Hanson-Netmotion does not specifically mention the module receives frames directed to a predefined port independent of a protocol address.

Ullmann-IBM discloses the well-known concept of having a module to receive frames directed to a predefined port independent of a protocol address (e.g., paragraphs 16 and 152, figures 2F and 2G).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hanson-Netmotion with the teachings of Ullmann-IBM in order to facilitate having a module to receive frames directed to a

predefined port independent of a protocol address because the port would support providing content of the frames to the module regarding of the protocol address.

19. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson-Netmotion in view of Fuoco et al., 6,594,713, Texas Instruments (Hereinafter Fuoco-Texas).

20. Referring to claims 15 and 16, Hanson-Netmotion does not specifically mention the further claimed limitations of claims 15 and 16.

Fuoco-Texas discloses an external port and an internal port (e.g., second paragraph of "Background of the Invention"), wherein the direct access module is only enabled on the internal port (e.g., figures 1, 3, 10, col., 8, lines 33 - 58), wherein the direct access module is disabled a predetermined time after power up (e.g., figures 1, 3, 10, col., 8, lines 33 - 58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hanson-Netmotion with the teachings of Ullmann-IBM in order to facilitate usage of the internal port, the external port and the power up because the external port would support communicating to the external devices. The internal port would support providing information to the module of a network entity. The disabling of the module would support power cutback.

Conclusion

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the

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convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Haresh Patel

November 9, 2006